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EXAMINER

COBURN, CORBETT B

ART UNIT PAPER NUMBER

3714

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/603,539

Applicant(s)

PENRICE, STEPHEN

Examiner

Corbett B. Coburn

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-42 and 58-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-42 and 58-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. In a reply dated 20 December 2005, Applicant elected claims 25-42 & 58-61 with traverse. However, Applicant failed to provide reasons for the traversal. Thus the traversal is void and is considered an election without traverse. (MPEP §818.03(a)) Furthermore, Applicant has cancelled the non-elected claims. This is also considered an election without traverse. (MPEP §818.02(c))

2. The restriction requirement is hereby made final.

### ***Claim Interpretation***

3. The phrase “government sponsored” in the preamble of claims 58-61 does not breath life into the claims. The game system is the same no matter who owns or sponsors it. Since “government sponsored” does not affect the claimed structure, it cannot add meaning to the claim.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 38 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 38 contains limitations directed toward a person. Such claims are non-statutory. Examiner interprets claim to mean that there are multiple players and that a player may use a wild symbol.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 25-27, 29-40 & 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Banyai (US Patent Number 6,702,668).

**Claim 25:** Banyai teaches electronic player stations including a value input device (i.e., a device for entering wagers). (Col 3, 31-38) Such electronic player stations inherently include a controller operatively coupled to the value input device comprising a processor and a memory operatively coupled to said processor. The controller is programmed to receive wager data in response to a wager made by a person on a game. The wager data includes a first plurality of indicia of a first type selected by said person (i.e., numbers – Col 3, 64-66). The controller is programmed to receive data representing a second plurality of indicia of the first type, said second plurality of indicia of said first type being randomly selected (i.e., the system randomly “draws” numbers, Fig 1, 16). The controller is programmed to replace one or more of said indicia of a first type in at least one of said first plurality of indicia and said second plurality of indicia with an indicia of a second type (i.e., wild symbol, Col 2, 1-5). The controller is programmed to determine whether any of said first plurality of indicia of a first type match any of said second plurality of indicia of a first type. (Fig 1) The controller is programmed to match said

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indicia of a second type with at least one of said second plurality of indicia of a first type if said indicia of a second type replaced an indicia of a first type from said first plurality of indicia. (Col 2, 1-5) The controller is programmed to match said indicia of a second type with at least one of said first plurality of indicia of a first type if said indicia of a second type replaced an indicia of a first type from said second plurality of indicia. (Col 2, 1-5) The controller is programmed to determine a value payout associated with an outcome of said game. (Fig 1, 20)

**Claim 26:** Banyai teaches a display unit that is capable of generating video images, wherein said controller is operatively coupled to said display unit, and wherein said controller is programmed to cause a video image to be generated on said display unit, said video image representing a lottery game. (Col 3, 35-37)

**Claim 27:** The video image comprises a plurality of lottery numbers. (Col 3, 60-61)

**Claim 29:** The video image comprises said first plurality of indicia of a first type including said indicia of a second type – i.e., they are all numbers.

**Claim 30:** The indicia of a first type comprise lottery numbers. (Col 3, 60-61)

**Claim 31:** The controller is programmed to make an automated selection of said first plurality of indicia of a first type in response to an action by said person – i.e., quick-pick. (Col 3, 64, Col 4, 2)

**Claim 32:** The controller is programmed to randomly select said second plurality of indicia of said first type. (Fig 1, 16)

**Claim 33:** The controller is programmed to randomly replace said one or more indicia of a first type with said indicia of a second type – i.e., the wild symbol can be used to match any of the player-selected numbers.

**Claim 34:** The controller is programmed to receive wager data representing a plurality of wagers, each of said wagers comprising a first plurality of indicia of a first type selected by a person, wherein said controller is programmed to select a wager from said plurality of wagers, and wherein said controller is programmed to replace an indicia from said first plurality of indicia of a first type of said selected wager with an indicia of a second type – i.e., the wild symbol can be used to match any of the player-selected numbers.

**Claim 35, 36:** The controller is programmed to associate a multiplier factor with said wager, and is programmed to multiply said value payout by said by said multiplier factor.

Col 4, 33-64 describes determining the payout based on the number of matches and whether they are matched in numerical order. There are also different prize amounts based on how many numbers are drawn in order to achieve a certain number of matches. Col 5, 20-39) Since the prize amount is determined based on random events, this means that the multiplier value is randomly assigned.

**Claim 37:** The controller is programmed to randomly associate the multiplier factor with said indicia of a second type. If the winning combination is dependent on the presence of a wild indicium (indicia of the second type), then the prize value is adjusted. (Col 6, 33-36)

**Claim 38:** The controller is programmed to receive wager data in response to wagers made by a plurality of persons, each of said wagers comprising a first plurality of indicia of a first type selected by a person, wherein said controller is programmed to select a person from said plurality of persons, and wherein said controller is programmed to replace an indicia from said first plurality of indicia of a first type of said selected person with said indicia of a second type. Figure 2 shows a multiplayer game in which a player may use a wild designator.

**Claim 39:** The gaming apparatuses are interconnected to form a network of gaming apparatuses. (Col 3, 43-54)

**Claim 40:** The controller is programmed to receive wager data representing at least one wager from each of said gaming apparatuses, each of said wagers comprising a first plurality of indicia of a first type selected by a person, wherein said controller is programmed to select one or more of said plurality of gaming apparatuses, and wherein said controller is programmed to replace an indicia from said first plurality of indicia of a first type of said one or more selected gaming apparatuses with said indicia of a second type. (Fig 2) When a wild indicium is drawn, it may be used to replace an indicium of the first type on all gaming machines.

**Claim 42:** Banyai teaches a network which may be the Internet.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 28, 41, & 58-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banyai as applied to claims 26 or 39 (if applicable) in view of Heidel et al. (US Patent Number 5,342,047).

**Claims 28, 41, & 58-61:** Banyai teaches the invention substantially as claimed (see above), but does not teach printing tickets. Heidel teaches a video lottery system that includes a ticket printer (48). Printing tickets for video lottery systems is extremely well known to the art. Such tickets provide a record of play (as required by gaming regulations) as well as allowing video lottery terminals to be placed in non-secure areas by separating the cash paid as a prize from the machine itself. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Banyai in view of Hiedel to include a ticket printer in order to provide a record of play (as required by gaming regulations) and allow the video lottery terminals to be placed in non-secure areas by separating the cash paid as a prize from the machine itself.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Corbett B. Coburn', with a stylized flourish at the end.

Corbett B. Coburn  
Examiner  
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